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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,071	04/15/2004	Alfred Stett	WWELL73.009C1	7156
20995	7590	11/01/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			JOHNSON, SHEVON ELIZABETH	
			ART UNIT	PAPER NUMBER
			3766	

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/825,071	STETT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shevon E. Johnson	3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-7 and 9-24 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-6, 10-11 and 20-24 is/are allowed.
- 6) ☒ Claim(s) 7, 9 and 17 is/are rejected.
- 7) ☒ Claim(s) 3-6, 10 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is in response to applicant's amendment received on 8/11/2006.

### *Response to Arguments*

2. Applicant's remarks have been fully considered but they are deemed moot in view of the new grounds of rejection. The Examiner points out that claims 7, 9, 12-19 are broad in comparison to claims 3-6, 10-11 and 20-24. Specifically, "an electrode arrangement" reads on a multitude of devices for the electrical stimulation of biological material some of these devices include cochlear implants, pacemakers and neural stimulators. The Examiner suggests that the Applicant amend claims 7, 9, 12-19 rendering them dependent upon independent claim 20 drawn to a retina implant.

### *Claim Objections*

3. Claims 3-6 and 10-11 are objected to because of the following informalities: "The electrode arrangement" should be changed to "The retina implant". Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 7 and 17 rejected under 35 U.S.C. 102(b) as being anticipated by Carter (U.S. Patent No. 5,674,264).

In regards to claim 7, Carter discloses an electrode arrangement for electrical stimulation of biological material (Figs. 1, 2 and 4), having at least one stimulation electrode 16 via which the biological material can be fed a stimulus signal, and having at least one counter electrode 19 which forms a counter pole to the stimulation electrode, wherein at least one sensor electrode 16 and/or 30 is provided with the aid of which it is possible to determine a polarization voltage across the stimulation electrode (col. 2, lines 43-57 and col. 5, lines 61-67), which further includes a control loop which varies at least one parameter of the stimulus signal as a function of the determined polarization voltage (col. 3, lines 31-43).

In regards to claim 17, Carter discloses an electrode arrangement for electrical stimulation of biological material (Figs. 1, 2 and 4), having at least one stimulation electrode 16 via which the biological material can be fed a stimulus signal, and having at least one counter electrode 19 which forms a counter pole to the stimulation electrode, wherein at least one sensor electrode 16 and/or 30 is provided with the aid of which it is possible to determine a polarization voltage across the stimulation electrode (col. 2, lines 43-57 and col. 5, lines 61-67), wherein the sensor electrode and the stimulation electrode are produced from the same material (col. 2, line 43 - col. 3, line 13).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carter (U.S. Patent No. 5,674,264) in view of Adams (U.S. Patent No. 6,390,971).**

In regards to claim 9, Carter discloses the system substantially as claimed except wherein the memory can be written and read from in a wireless fashion. However, Adams teaches memory can be written and read from in a wireless fashion (col. col. 1, line 52 – col. 2, line 37).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Carter by incorporating the wireless capability as taught by Adams in order to provide programming capability to the physician or patient.

***Allowable Subject Matter***

8. Claims 3-6, 10-11 and 20-24 are allowed, these claims recite combinations not disclosed in the art.

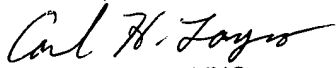
***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shevon Johnson whose telephone number is (571) 272-2010. The examiner can normally be reached on M-F (8 a.m. - 4:30 p.m.). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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